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EXAMINER
OGDEN, N

ART UNIT	PAPER NUMBER
1105	10

11M1/1222

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DATE MAILED: 12/22/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 10-19-93 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1 - 28 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 2-4, 6, 7, 9-13, 19, 25 and 26 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1, 5, 8, 14-18, 20-24, and 27-28 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____ ; filed on _____.

13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

This action is responsive to the amendment filed October 7, 1993.

Applicant's amendments have necessitated the new ground of rejections.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
> Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Evaluations of the level of ordinary skill in the art requires consideration of such factors as various prior art approaches, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, and failure of others.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The evidence of record including the references and/or the admissions are considered to reasonably reflect this level of skill.

Claims 1, 5, 8, 14-18, 20-24, and 27-28 are rejected under 35 U.S.C. § 103 as being unpatentable over WO '849 in view of EP '979.

WO '849 discloses a liquid composition comprising a major amount of at least one fluorine containing hydrocarbon and a minor amount of at least one soluble organic lubricant, wherein said lubricant comprises an ester of a polyhydroxy compound and characterized by the general formula $R[CO(O)R^1]n$ in which R is a hydrocarbyl group, a straight chain lower hydrocarbyl group, and R^1 is a carboxylic acid or a carboxylic acid ester-containing hydrocarbyl group and n is an integer, (pg. 5 lines 19 -pg. 6, line 7) wherein said formula represent applicant's formula II in claim 1 part (B). WO '849 discloses all of the instantly required except applicant's specific combination of fluorine containing hydrocarbons.

EP '979 discloses a refrigerating apparatus comprising a refrigeration cycle comprising at least a refrigerant composed of fluorocarbon type refrigerant containing no chlorine and a refrigerating machine oil which include esters of neopentyl glycol, pentaerythritol and dipentaerythritol (pg. 6, lines 10-pg. 7, line 10). Furthermore, EP '979 teaches that said refrigerant includes 1,1,1,2--tetrafluoroethane, difluoromethane, or pentafluoroethane used singly or as a mixture thereof (pg. 7, lines 31-41).

Absent a showing of new of unobvious results it would have been obvious to one of ordinary skill in the art to include the mixture of fluorine containing refrigerants of EP '979 to the liquid composition of WO '849 because EP '979 teaches that said mixture may be included in combination with neopentyl glycol esters. Furthermore, as WO '849 employs many of the same refrigerants as EP '979 and one of ordinary skill in the art would expect similar results with the employment of a mixture of conventional fluorine containing refrigerants.

The rejection of claims 1-27 under U.S.C. 103 as being unpatentable over McGraw '144 alone or McGraw '180 in view of Zehler et al is withdrawn.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden whose telephone number is (703) 308-0661.

Necholus Ogden
December 20, 1993

Paul Lieberman

PAUL LIEBERMAN
SUPERVISORY PRIMARY EXAMINER
ART UNIT 115